

**REMARKS****OVERVIEW**

Claims 1-16 are pending in this application. Claims 1, 2, 6, 8, 11, and 13 have been amended. Claim 16 is new. The present response is an earnest effort to place all claims in proper form for immediate allowance. Reconsideration and passage to issuance is therefore respectfully requested.

**ISSUES UNDER 35 U.S.C. § 103**

Claims 1-5, 7, 8, and 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lehmkuhl '495 in view of Buckley et al '380. These rejections are respectfully traversed.

Claim 1 has been amended to clarify that the aperture is "in the body." It appears that the Examiner considered the aperture in the body as an aperture associated with the sleeve. This is not the case—where a sleeve is used, there is a separate aperture. See FIG. 3 and the accompanying text in the Specification for clarification. The sleeve 40 includes an opening 42 and the sleeve protects and holds the name tag 32. Note that the sleeve 40 and its opening 42 are separate structures from the aperture 22 in the body. Claim 1 as amended makes clear that there is an aperture in the body.

Neither Lehmkuhl nor Buckley disclose such an aperture in the body, let alone one with "a replaceable name tag positioned within the aperture of the body." Therefore, this rejection to claim 1 must be withdrawn on this basis.

The Examiner is correct in that Buckley discloses a pocket 17, however note that the pocket 17 of Buckley is merely placed on the top surface of the body. The pocket 17 of Buckley

could not be placed underneath the body because there is no aperture in the body. It is further observed that in a context such as Buckley, it would be advantageous to insert materials into a pocket from the front surface, however, in the "desktop teaching aid for presenting educational material" context of the present invention, it would be disadvantageous to insert materials into a pocket on the front surface of the teaching aid because this would be distracting to students who may pick at the pocket, insert their own materials into the pocket without permission, or modify the materials in the pocket. This type of potentially disruptive activity is minimized with the present invention as claimed because due to the aperture in the body, the pocket may attach to the back of the body.

Claim 2 as amended provides a further basis for patentability as claim 2 now requires that sleeve is "attached" to the "bottom surface" of the body. Note that in Buckley the sleeve is on the top surface. The advantages of having the sleeve on the bottom surface in the context of a teaching aid have already been discussed. In particular, having name tags insertable into a sleeve from only the body surface, better protects the name tag from the student and removes distractions to the student. Therefore, it is respectfully submitted that this rejection to claim 2 must be withdrawn for this independent reason. It is also observed that this amendment to claim 2 incorporates at least the subject matter of previous claim 6 and previous claim 6 was not rejected based on the combination of Lehmkuhl and Buckley. Therefore this rejection to claim 2 should be withdrawn for this independent reason as well.

Claims 4 and 5 have an independent basis for patentability as well. The Examiner indicates that it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include matching decorative designs on a name tag and body of the teaching aid as well as educational material on the name tag since it would only depend on the intended

use of the assembly and the desired information to be displayed citing to *In re Gulack* for support (Office Action, p.3). These rejections are respectfully traversed.

*In re Gulack*, 217 USPQ 401, (CAFC 1983), makes clear that "Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *Id.* at 403. "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 404.

The functional relationship between the educational material, the name tag, and the body include: (1) the name tag supports the educational material or name information; (2) the name tag is removable and replaceable relative to the body; (3) the educational material or name information is removable and replaceable relative to the body. These differences are critical to the invention. For example, one of the very objects, features, or advantages of the invention is "to provide a teaching aid that allows teachers to replace or update educational material associated with the teaching aid." (Specification, p. 1, lines 28-30). By further example, the Specification states "The name tag 32 is positioned so that the aperture 22 in the body 20 frames the name tag 23. This provides a number of advantages. The teacher can replace the name tag 32 throughout the school year with different educational materials. This greatly enhances the value of a desktop teaching aid as a learning tool." (Specification, p. 3, lines 23-26).

The Examiner cites to page 4, lines 28-31 of the specification as supporting the argument that there is no advantage or critical need for the decorative design or the placement of the educational material. Such reliance is misplaced. Certainly variations in the educational material and decorative design elements are contemplated. What the Examiner has not considered is the

importance of the location in the apparatus where the educational material and decorative design elements are placed—namely, on the removable and replaceable name tag.

The Applicant further notes the Examiner cites to *In re Ngai*, 367 F.3d 1336, 70 U.S.P.Q.2d 1862, which merely stands for the proposition that an applicant is not entitled to patent a known product by simply attaching a set of instructions to that product. *In re Ngai* is therefore of no particular relevance to the present situation.

Therefore, these rejections to claims 4-5 must be withdrawn for these independent reasons.

With respect to claim 8, claim 8 has been amended to positively recite "a replaceable name tag" and to specify that the replaceable name tag region is "on the body" and "adapted" for securing the replaceable name tag. Lehmkuhl does not disclose "a replaceable name tag" or "a replaceable name tag region on the body adapted for removably securing the replaceable name tag to the body" or "the replaceable name tag including additional educational material." The Examiner attempts to combine Lehmkuhl with Buckley. In doing so the Examiner does not specifically address claim 8, and it is respectfully submitted that the Examiner has not fully considered the nature of the problem being solved by the present invention relative to Lehmkuhl and Buckley.

Where a prior art reference is directed towards solving a different problem, one skilled in the art would be less likely to consider the teachings of the prior art reference in solving the problem addressed by the inventor ("The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability." *In re Bisley*, 197 F.2d 355, 94 U.S.P.Q. 80, 86 (C.C.P.A. 1952); "The problem

solved by the invention is always relevant." *In re Wright*, 838 F.2d 1216, 6 U.S.P.Q.2d 1959, 1961 (Fed. Cir. 1988); "A reference is not available under 35 U.S.C. § 103 if it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved." *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 U.S.P.Q. 403 (Fed. Cir. 1985)).

Here, neither reference is directed towards solving the problem addressed by the present invention. One of the problems addressed by the present invention is to provide a teaching aid that allows one to replace or update educational material associated with the teaching aid. Lehmkuhl is merely an example of a prior art teaching aid that does not allow a teacher to replace or update educational material. Thus, Lehmkuhl does not recognize this problem, let alone resolve it. Buckley is a game apparatus which is used for teaching favorable behavioral patterns. The nature of Buckley is as a game and it is believed that the Examiner focuses too much on the fact that the Buckley game is used for "teaching" and in doing so, ignores the invention as a whole. Buckley has add-on name pockets 17 which are used to indicate player's names. The addition of a name is not the addition of teaching material and the purpose of the add-on name pockets of Buckley is not to allow a teacher to replace or update educational material. The fact that Buckley's game may be used for "teaching" is not enough to provide a nexus between the Buckley reference and the desktop teaching aid. Therefore, it is respectfully requested the Examiner consider the differences in problem solved by the present invention and the prior art and withdraw this rejection to claim 8.

With respect to claim 13, claim 13 has been amended to clarify that the aperture is "in the body." Therefore, it is respectfully submitted that this rejection to claim 13 be withdrawn for this reason. As previously explained, neither Buckley nor Lehmkuhl have such an aperture in the

body. It is further submitted that it is improper to combine Buckley and Lehmkuhl in the manner suggested by the Examiner. As the Examiner recognizes, Lehmkuhl, discloses at paragraph 4, lines 52-54, "The student's name may also be recorded in a special location provided within desk mat 10." Thus, Lehmkuhl offers a complete solution to the placement of a student's name—merely marking the student's name directly on the desk mat. Thus, the Examiner's purported motivation to combine Buckley and Lehmkuhl is flawed. Thus, for all these reasons, this rejection to claim 13 should be withdrawn.

Claims 1-15 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable over Buckley et al '380 in view of Kollath et al '381. These rejections are also respectfully traversed. Various deficiencies of Buckley have already been discussed. With respect to claim 1, Buckley does not disclose "the body defining a frame around an aperture in the body." Nor does Buckley disclose "a replaceable name tag positioned within the aperture of the body." The Examiner cites to col. 4, lines 3-5 of Buckley as disclosing an aperture in the body. This is not correct. Buckley merely discloses that a name pocket for receiving a card may be disposed on the surface of the score unit. It does not disclose that there is an aperture in the body itself as now clearly required by claim 1. As there is no aperture in the body of Buckley, there can be no "replaceable name tag positioned within the aperture of the body" as also claimed. Kollath does not remedy these deficiencies. Kollath does not disclose "the body defining a frame around an aperture in the body" and thus also can not disclose "a replaceable name tag positioned within the aperture of the body." Therefore this rejection to claim 1 must be withdrawn. As claims 2-7 depend from claim 1, these rejections must also be withdrawn.

With respect to claims 4-5, 8-9, and 14-15, regarding the use of educational material and decorative designs, the basis for patentability has already been explained, and therefore the

printed matter rejection should be withdrawn. In particular, the Examiner has not properly considered the functional relationship between the body and a removable and replaceable name tags, which allow different information to be presented by a teacher without requiring replacement of the entire apparatus.

With respect to claim 13, claim 13 also requires "the body defining a frame around an aperture in the body" and "a replaceable name tag positioned within the aperture of the body." For the reasons previously expressed with respect to claim 1, this rejection to claim 13 must also be withdrawn. In addition, the criticality of this arrangement has already been explained.

#### NEW CLAIM

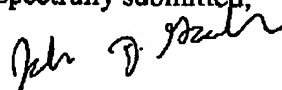
New claim 16 contains subject matter similar to original claim 4.

#### CONCLUSION

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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